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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,266	06/25/2003	Mitsutaka Hanyu	GKS 394	3384

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EXAMINER	
NGUYEN, KIMBERLY D	
ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/606,266	HANYU ET AL.	
	Examiner	Art Unit	
	Kimberly D. Nguyen	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-10,12,13 and 17-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-10,12,13 and 20* is/are rejected.

7)☒ Claim(s) *17-19 and 21-24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/14/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Acknowledgment is made of Amendment filed October 24, 2005.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 1 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed October 24, 2005. In that paper, applicant has stated "Applicants' Claim 1 recites a price indication label wherein "at least a part of the surface material of the advertisement region comprises a see through material for enabling reading of printed information provided on a surface that the label is attached to". This feature is illustrated in Applicants' Figures 6-8, for example, by the advertising marked display region 205 which overlies a portion of the tag 210 as illustrated in Applicants' Figure 8 to enable viewing of at least a portion of the printed information (price) from the tag." (see the last 6 lines of page 10 through first 4 lines of page 11) and this statement indicates that the invention is different from what is defined in the claim(s) because the claimed language, such as claim 1, is vague to follow through in according with figures 6-8 as suggested by applicants.

On January 4, 2006, the examiner called the attorney of record Mr. Brian Tumm for some insight/discussion on the invention and the independent claims. Mr. Tumm acknowledged that

independent claim(s), such as claim 1, is somewhat confusing and suggested that the examiner to look over independent claim 12, which is more relevant to the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 6-7, 9-11, 13-14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Mehta et al. (US 5,810,397; hereinafter "Mehta").

Re claims 1, 9-10: Mehta teaches a price indication label (10 in figs. 1-2) comprising an attachable label body which has a price indication region (26) capable of indicating a current price (e.g., $14.99 in fig. 2) and an advertisement region (28) capable of advertising information for sales promotion, wherein the surface material of the price indication region (26) and the surface material of the advertisement region (28) are different from each other (col. 2, lines 31-49; col. 7, line 60 through col. 8, line 63), wherein at least part of a surface material of the advertisement region (28) comprising a see through material for enabling reading printed information on a surface that the label is attached to (i.e., "a see through material for enabling reading printed information on a surface that the label is attached to" has been broadly interpreted by the examiner as that the advertisement region (28) having a see through material for enabling reading printed information, such as "Bremerton's Fashion" and/or "On Sale" can be seen through from the advertisement region 28.)

Re claim 2: Mehta teaches the price indication region (26) has been imaged to provide a back machine readable code (30), wherein the advertisement region (28) has been imaged with a store name in a different color than area (26) (col. 8, lines 12-20), which is at least one of surface materials of the price indication region and the advertisement region having a different color ink for printing.

Re claim 3: Mehta teaches the price indication region (26) having the thermally imagable coating (18), and the advertisement region (28) having thermally imagable coatings (18, 24) (col. 8, lines 1-20), wherein the thermally imagable coatings (18, 24) are a thermo sensitive multi color fixing agent.

Re claims 6, 11 and 14: Mehta teaches a back surface (second surface 16 in fig. 4A) corresponding to the price indication region having a layer of adhesive material (42 in fig. 4A) (col. 9, lines 6-13; col. 3, lines 41-48).

Re claims 7, 13 and 16: Mehta teaches the label (10), which is typically made of paper or synthetic film substrate (col. 5, lines 26-34), which the label (10) is, inherently flexible/bendable, capable for being folded toward to the back surface (16) of the label to glue the folded part to the back surface so as to free from being attached.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 5, 12, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta in view of Watanabe et al. (Japanese Publication number 2001-154584 cited by Applicants; hereinafter "Watanabe".) The teachings of Mehta have been discussed above.

Mehta fails to specifically teach or fairly suggest a cancel indication mark for blocking/denying a portion of the printed information viewable through the see through material when attached a tag.

Watanabe teaches a label having the double-lines crossing through item A_5 in figs. 5-6, which serves as a cancel indication mark for denying the printed information through the material being attached the label.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the double-lines crossing through item as the cancel indication mark as taught by Watanabe to the teachings of Mehta in order to allow the printed information to be adjusted/strike-through to further provide the user the history of the information printed on the label.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta in view of Sugita (JP407160200). The teachings of Mehta have been discussed above.

Mehta teaches a fold line, which is the line between the surfaces (26 and 28 in fig. 2) by folded toward the back surface.

Mehta fails to specifically teach or fairly suggest the fold line having perforations.

Sugita teaches a price tag (figs. 1 and 7) having a cutting-line (6), which has perforations.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the well-known cutting-line with perforations as taught by

Sugita to the teachings of Mehta in order to ease the separation/folding between regions of the label.

Allowable Subject Matter

9. Claims 17-19 and 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or fairly suggest the step of including providing a cancellation mark in the transparent advertisement region, wherein the step of aligning the transparent advertisement region comprises canceling out with the cancellation mark a portion of a displayed price on the merchandise tag that is viewable through the transparent advertisement region.

Response to Arguments

11. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection as set forth in the instant Office action.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KDN
January 7, 2006

MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
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